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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,456	06/26/2003	Jason Goldsmith	JGO1-G90	9389

7590

11/04/2005

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/608,456

Applicant(s)

GOLDSMITH, JASON

Examiner

Sebastiano Passaniti

Art Unit

3711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: as stated in the Final Rejection, mailed 08/09/2005.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Sebastiano Passaniti
Primary Examiner

Continuation of 3. NOTE:

The language added to claim 1 and further stating that the cylindrical wall has a larger cross-sectional diameter at a face end and a smaller cross-sectional diameter at an opposing end does not find proper antecedent basis in the specification. For instance, beginning at page 8, line 21 and continuing through page 9, line 21 of the specification, the applicant details that which is shown in Figures 6-8. While the dome (72B) is described as providing a sleek appearance and while the dome is shown in Figure 8 as assuming a narrower height of the alignment assembly from the face of the club head body to a rear thereof that would lead to a smaller cross-sectional dimension at the tail end of the alignment assembly, there is no clear inclusion of the newly claimed language. True, applicant may be his or her own lexicographer in drafting the claims, but only if such drafting of the claims remains consistent with that which is disclosed and detailed by the originally-filed specification, claims and drawings. Here, the newly claimed language sought to be inserted in claim 1 does not appear to find full and proper basis in any of the originally-filed specification, claims or drawings.

The language added to claims 2 and 15 and further detailing the dimension of the slot would appear to hint at the inclusion of new matter within the claims. While numerous references are made in the specification to the distance between the top surface of the dome and the projection surface as being at least twice the width or thickness of the slot so that the image can only be seen when the golfer's eyes are properly aligned, there is no clear description for the newly claimed language that stipulates that the slot be dimensioned small enough to prevent seeing more than a single line on the head top surface.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's comments with respect to the citation of the prior art to Kaise, Innes and Hamilton are acknowledged. Further, applicant's arguments with respect to the alleged inappropriateness of the mailing of a final rejection are acknowledged. In response to these arguments, note the following:

It is noted that the 08/09/2005 Office action states that the prior art references to Kaise and Hamilton are "of record". The action should have further mentioned that these two references are of record in the related, pending 10/808,710 application. Any inconvenience to the applicant for inadvertently indicating that the Kaise and Hamilton references were already of record in this 10/608,456 application is sincerely regretted. Nonetheless, the finality of the rejections in the 08/09/2005 Office action STANDS. On page 5 of the 10/11/2005 "Remarks", the applicant incorrectly states that the rejections have been made final on a first office action. Note, a first action on the merits was mailed on 06/01/2004, after which applicant presented an amendment to the original claims 05/18/2005. The amendments to the original claims created the need for further search and consideration of the claimed subject matter. The references to Kaise, Hamilton and Innes were sought and applied to reject the amended claims. It is noted that a final rejection is proper on a second action using prior art not of record where a claim has been amended to include limitations, which could not reasonably have been expected to be claimed. Although the applicant argues that the amended claims simply seek to clarify the claimed subject matter and do not necessitate any new grounds of rejection, a simple comparison between the originally-filed claims, received 07/10/2003, with the first set of amended claims, received 05/18/2005, reveals that substantial changes were introduced within the text of the claims. In essence, every amendment to a claim is an attempt to further clarify previous claimed language. However, where these amendments can not be reasonably expected, a final rejection based upon newly cited art on the second action is clearly appropriate. See MPEP 706.07(a).

Insofar as the rejection of claim 12 as being anticipated by Innes, the applicant has not amended the claim to define over the structure in Innes. It would appear that the applicant is seeking further clarification regarding the §102(b) rejection based upon Innes. Based on the applicant's own definitions of what can be considered a darkened portion or a lightened portion, it is clear that Figure 1 in Innes shows both a darkened portion, i.e., an area between two sight grooves (16) and a lightened portion, i.e., an area on the top surface (4) of the head.

Further, the applicant has not addressed the obviousness-type double patenting rejection set forth on pages 4-5 of the 08/09/2005 final rejection.


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